

## REMARKS

### Formalities

The examiner has objected to the claim numbering stating that claim 74 was missing. Actually, the source of the missing claim number was that there were two claims numbered 65. The error has since been corrected by this amendment. The examiner further noted that corrected drawings are required. Formal drawings have been forwarded as a separate paper under a cover letter addressed to the official draftsman. A file copy of the formal drawings for the convenience of the examiner is enclosed herewith. Lastly, a power of attorney is enclosed herewith. Please correct the correspondence address and attorney file reference in this case.

### Obviousness

The examiner rejected all claims under 35 U.S.C. §103(a) as being obvious over US patent 5,961, 603 to Kunkel, et al. Applicants respectfully traverse the §103(a) rejection and request reconsideration.

In the system of the present claims (66-76), selectable presentations (which may be received over the Internet in HTML format) are processed by "converting said selectable presentations to MPEG digital video format" and stored in "a presentation database memory". The conversion and storage (e.g., from HTML) to MPEG digital video format is significant, not so much for saving storage memory, as for providing rapid response to user

requests, since the user terminal already has an MPEG decoder, which is normally used for MPEG video programming.

The features of MPEG are advantageous in presenting digital information. Claim 67 recites the use of an MPEG I-frame, which can form a still image. Claim 68 recites the use of an MPEG P-frame, which can form a data overlay.

The examiner correctly notes that Kunkel et al. do not suggest using MPEG to store selectable presentation forming the downloaded information. MPEG is a digital video format originally designed for video, i.e., to render motion or moving pictures. Kunkel et al. only suggest using MPEG for the normal video program portion. Kunkel et al.'s disclosure is to place an ID tag on the video signal so that it can be correlated to a desired URL. Once the ID tag on a video program signal is selected by the user and transmitted back upstream to the headend, Kunkel et al. assert the bare conclusion that the selected information is then downloaded to the user. Kunkel et al. do not say anything about how the selected information is downloaded to the user.

For example, Kunkel et al. state that "The network headend ... downloads HTML Web page data from the Internet to the requesting user" (abstract line 14-15). They reiterate that the headend "download(s) the associated Internet information to the user's set top converter box" (column 2, lines 55-57). If anything, Kunkel et al. point away from using MPEG, when they suggest that downloaded information should be in a standard HTML Internet format. Kunkel et al. specifically state: "The HTML data is then downloaded by the browser 74 to

the user on the selected downstream channel for display on their television 24.” (column 13, lines 19-21).

The examiner takes “Official Notice” that “it is well known in the art to store data in MPEG format to provide compressed storage for utilizing less memory” and that “it would have been well known in the art to include positional data with interactive content...”. Applicants note that it is improper for the examiner to combine his present knowledge of MPEG with Kunkel et al. for several reasons:

1) Kunkel et al.’s actual disclosure points away from MPEG by expressly using HTML formatted Internet information.

2) Present public knowledge by the examiner is not prior art to an application filed February 22, 1999. Furthermore, using less memory for MPEG storage versus HTML storage, (alleged to be the case by the examiner), is incidental; the more significant feature resulting from the use of presentations in MPEG digital video format is the speed of response to a user request.

With regard to claim 65, the examiner similarly asserts that it is his personal knowledge that “it would have been well known in the computer are [sic] to include the claimed limitations to monitor and keep track of data sent to a user based on a user’s ID” as of the filing date of the application. As required by patent office rules,

“When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as

specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.”, MPEP 1.104(d)(2)

3) The examiner is using impermissible hindsight. Typically, an examiner, using applicant's disclosure as a guide, will find pieces and parts of the claimed subject matter in the prior art. However, it is not always proper to combine references found in this manner. The search results, although found by using applicant's invention as a roadmap, must thereafter be viewed prospectively. That is, aside from the hindsight provided by applicant's own disclosure, there must be some motivation in the references themselves to suggest their combination.

In this case, the examiner, using applicant's disclosure as a guide, found some parts of the claimed subject matter in the prior art. The examiner then took “Official Notice” of the parts not found. Assuming, *arguendo*, that MPEG encoding, per se was known in 1999, it would still not be obvious from such prior art to make the claimed combination. Kunkel et al. at column 12, lines 45-62 say:

In the operation of the channel hyperlinking system 10, each of the headends 14 preferably pre-caches from the ISP 30, the HTML data pertaining to the channel hyperlinks associated with upcoming programming prior to the broadcasts, and stores this information in the cache 31. As the video programs are received from the satellite 26 and the ID tag data stream is received from the second satellite 43, the headend 14 collects the hyperlink ID tags from the data stream, thereby reducing the hardware costs at the headend 14. At any given instant, the headend 14 can therefore identify the program content of any channel. The headend 14, upon receiving the URL data from the master database 42, can also retrieve the Web information located at the URL address from the ISP 30. As discussed previously, while it is preferable that this procedure be carried out in advance of a video broadcast to facilitate faster processing of hyperlink requests, this process can also be done in real-time if necessary.

Thus, Kunkel et al. suggest using HTML as the storage format in memory cache 31 at the headend. There is no motivation, except for applicants' own disclosure, for the examiner to make the substitutions resulting in the claimed combination. Accordingly, Kunkel et al., alone or in combination with the other cited art do not fairly suggest the claimed combination.

With regard to claims 66-70 and 71, the examiner alleges, "Kunkel discloses the claimed MPEG limitations." (examiner's office action, page 4, line 10) However, the office action also takes the opposite position, "Kunkel fails to disclose the claimed storing the selectable presentation in MPEG digital format in a presentation database memory." (examiner's office action, page 3, lines 9-10). Kunkel et al. fail to disclose storing presentations in MPEG digital format. Kunkel et al. also fail to disclose storing presentations in MPEG P-frames.

#### Conclusion

For the reasons given above, it is requested that the examiner reconsider the claims, as renumbered, withdraw the rejection of claims under 35 U.S.C. §103(a) and pass the present application to issue.

Respectfully submitted,



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